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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,396	12/18/2001	Bradley S. Emalfarb	254.00069	4852

7590

01/25/2005

WOOD, PHILLIPS, VAN SANTEN, CLARK & MORTIMER  
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CHICAGO, IL 60661

EXAMINER

GORDON, RAEANN

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SH

<b>Office Action Summary</b>	<b>Application No.</b> 10/025,396	<b>Applicant(s)</b> EMALFARB, BRADLEY S.	
	<b>Examiner</b> Raeann Gorden	<b>Art Unit</b> 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 19-31 is/are pending in the application.
- 4a) Of the above claim(s) 30 and 31 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-25, 28 and 29 is/are allowed.
- 6) ☒ Claim(s) 1-17, 19, 26 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-17 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed does not include the following subject matter: 1) the first performance characteristic that is detectable by a golfer by striking the golf ball with a golf ball after at least two days of being immersed in water 2) a difference between the first and second performance characteristics being detectable by striking the golf ball with a golf club. See claims 1, 10 and 19.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-17, 19, 28, and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Finkel (2002/0094885). Regarding claim 1, Finkel discloses a golf ball comprising a spherical outer surface wherein the surface includes a material that degrades when exposed to water for a period of less than three days, such as a biodegradable resin. The golf ball inherently changes shape and diameter once the shell/surface degrades (pg. 5, 55;pg. 6, 71). Regarding claim 2, the golf ball may include dimples (pg. 6, 73). Regarding claim 3, the golf ball includes a core and cover (pg. 6, 71). Regarding claim 4, figure 3B shows the cover thickness less than one third of the diameter of the entire golf ball. Regarding claim 5, the cover/outer shell may be made entirely from the degradable material, resin. Regarding claim 6, the outer shell may include fillers (pg. 6, 68). Regarding claim 7, the material may include resins or polyesters (pg. 6, 67). Regarding claim 8, the time period is three days or less. Regarding claim 9, the material will change shape and diameter by melting (abstract). Regarding claim 10, Finkel discloses a golf ball comprising a spherical outer surface wherein the surface includes a material that degrades when exposed to water for a period of less than three days, such as a biodegradable resin. The golf ball inherently has a different performance characteristic once the shell/surface degrades (pg. 5, 55;pg. 6, 71). Regarding claim 11, the material will change shape and diameter by melting (abstract). Regarding claim 12, the golf ball may include dimples (pg. 6, 73). Regarding claim 13, the golf ball includes a core and cover (pg. 6, 71). Regarding claim

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14, figure 3B shows the cover thickness less than one third of the diameter of the entire golf ball. Regarding claim 15, the cover/outer shell may be made entirely from the degradable material, resin. Regarding claim 16, the outer shell may include fillers (pg. 6, 68). Regarding claim 17, the material may include resins or polyesters (pg. 6, 67). Regarding claim 18, the time period is three days or less. Regarding claim 19, Finkel discloses a golf ball comprising a plurality of layers made from a material that degrades when exposed to water for a period of less than three days, such as a biodegradable resin. The golf ball performance characteristics will inherently change once the layers degrades (pg. 6, 65).

Claims 26 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Yoshida et al (6,315,683). Applicant claims a hollow golf ball comprising a capillary that is at least partially filled. Yoshida discloses a golf ball with a hollow core. The presence of a capillary is moot since the capillary may be completely filled. Please note, the layers of Yoshida are made from different materials, which satisfies applicant's limitation.

#### ***Allowable Subject Matter***

Claims 20-25, 28, and 29 are allowed.

#### ***Response to Arguments***

Applicant's arguments filed 12-3-04 have been fully considered but they are not persuasive. Applicant argues the golf ball of Finkel discloses the golf ball is made from

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a material that will quickly oxidize or degrade while the present invention is directed to a golf ball with delayed degradation. However, the point of degradation disclosed in Finkel clearly falls into the range claimed by applicant. Therefore the rejection is maintained. With respect to claims 26, the claim is written to include a capillary at least partially filled with a material different from the cover. Yoshida meets this limitation, applicant does not exclude materials from filling the remainder of the capillary, such as the cover material.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raeann Gorden whose telephone number is 571-272-4409. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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Rg

January 21, 2005



**RAEANN GORDEN**  
**PRIMARY EXAMINER**